REMARKS

By this Amendment, Applicant amends claims 1, 2, 4, 15, 17, and 28 for clarity. Claims 1-28 remain pending in this application.

In the Office Action mailed May 6, 2004, the Examiner objected to the Abstract; indicated that headings in the specification should appear in upper case lettering; rejected claims 1, 8, 10, and 12 under 35 U.S.C. § 112, second paragraph; rejected claims 1-7, 12-20, and 25-28 under 35 U.S.C. § 102(b) as anticipated by Buchanan et al. (U.S. Patent No. 5,267,155); rejected claims 8-9 and 21-22 under 35 U.S.C. § 103(a) as unpatentable over Buchanan in view of Van Huben et al. (U.S. Patent No. 6,327,594); and rejected claims 10-11 and 23-24 under 35 U.S.C. § 103(a) as unpatentable over Buchanan in view of Salas et al. (U.S. Patent No. 6,233,600).

I. OBJECTIONS TO SPECIFICATION

Applicant has amended the Abstract for clarity and for length. In particular, the Abstract is amended to be in narrative form and under 150 words in length. Accordingly, Applicant respectfully requests the Examiner to withdraw the objection to the Abstract.

Regarding the Examiner's objection under 37 C.F.R. § 1.77(b), to expedite prosecution, Applicant has amended the section headings "Field of the Invention" and "Description of Related" Art to be in upper case lettering. Applicant therefore respectfully requests the Examiner to withdraw the objection to the specification.

II. REJECTION OF CLAIMS 1, 8, 10, AND 12 UNDER § 112, ¶2.

Applicant has amended claim 1 to recite "second data" instead of "second information." Applicant respectfully submits that claim 1, as amended, and claims 8, 10, and 12, which depend therefrom, comply with the requirements of 35 U.S.C. § 112, second paragraph. Accordingly, Applicant respectfully requests the Examiner to withdraw the rejection of claims 1, 8, 10, and 12 under 35 U.S.C. § 112, second paragraph.

III. REJECTION OF CLAIMS 1-7, 12-20, AND 25-28 UNDER § 102(b)

Applicant respectfully traverses the Examiner's rejection of claims 1-7, 12-20, and 25-28 under 35 U.S.C. § 102(b) as anticipated by Buchanan. To properly anticipate Applicants' claimed invention under 35 U.S.C. § 102(b), the Examiner must demonstrate the presence of each and every element of the claim in issue, either expressly described or under principles of inherency, in a single prior art reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." *See* M.P.E.P. § 2121 (8th ed., Aug. 2001), *quoting* Richardson v. Suzuki Motor Co., 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Finally, "[t]he elements must be arranged as required by the claim." M.P.E.P. § 2131 (8th ed. Aug. 2001), p. 2100-69.

Claim 1 recites a combination including, among other things, "a module for scanning first data to be used by application software and extracting information for

searching a database" and "a module for extracting second data from a database on the basis of the extracted information." Buchanan does not disclose at least these features.

In rejecting claim 1, the Examiner cites column 5, lines 13-26 and 39-65, alleging Buchanan discloses the claimed module for scanning first data and the claimed module for extracting second data. Applicant respectfully disagrees. The Buchanan system allows a user to select a report to be generated to use a document template. The document template associated with the report is retrieved from nonvolatile memory. A computing device scans the document template for variable identifiers. When variable identifiers in the document are found, it lists the phrases contained in an option-text record associated with the variable identifier. See col. 5, lines 13-26. The Buchanan system further describes that a relational database may be used to maintain the document templates and the phrases used to replace variables in the templates. See col. 5, lines 39-65.

However, Buchanan does not teach at least "a module for scanning first data to be used by application software and extracting information for searching a database" and "a module for extracting second data from a database on the basis of the extracted information," as recited in claim 1. Buchanan thus does not anticipate the claim. Accordingly, Applicant respectfully requests the Examiner to withdraw the rejection of claim 1.

Independent claims 2, 14, and 15, while of differing scopes, include recitations similar to allowable claim 1, as well as additional recitations. For example, claim 2 recites a combination including, among other things, "an identification information extracting module for extracting the identification information by scanning the first data

to be used by application software; a search information extracting module for extracting

the first search information corresponding to the extracted identification information by

referring to the search information storage module" and "a data extracting module for

extracting second data by searching a database on the basis of the extracted first

search information."

Claim 14 recites a method including, among others, steps of "scanning first data

to be used by application software and extracting information for searching a database"

and "extracting second data from a database on the basis of the extracted information."

Claim 15 recites a method including, among others, "a search information

extracting step of referring to search information storage module for storing first

information for searching a database in association with identification information,

thereby extracting the first search information corresponding to the extracted

identification information" and "a data extracting step of searching a database on the

basis of the extracted first search information, thereby extracting second data."

Accordingly, claims 2, 14, and 15 are also allowable at least for the reasons

discussed above in regard to claim 1.

IV. REJECTION OF CLAIMS 8-9 AND 21-22 UNDER § 103(a)

Applicant respectfully traverses the rejection of claims 8-9 and 21-22 under 35

U.S.C. § 103(a) as unpatentable over Buchanan in view of Van Huben.

To establish a proper *prima facie* case of obviousness under 35 U.S.C. § 103(a),

the Examiner must meet each of the following three requirements. First, the reference

taken alone, or references combined, must teach or suggest each and every element

recited in the claims. *See* M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be

some suggestion or motivation, either in the references themselves or in the knowledge

generally available to one of ordinary skill in the art, to combine the references in a

manner resulting in the claimed invention. *See* M.P.E.P. § 2143.01 (8th ed. 2001).

Third, a reasonable expectation of success must exist. *See* M.P.E.P. § 2143.02 (8th

ed. 2001). Moreover, each of these requirements must be found in the prior art, and not

be based on applicant's disclosure. *See* M.P.E.P. § 2143 (8th ed. 2001).

Claims 8, 9, 21, and 22 depend from allowable claims 1, 2, 14, and 15,

respectively. Van Huben, which describes a method for enabling a central data

management system to interact with a pervasive computing device, does not make up

for the deficiencies of Buchanan discussed above. Accordingly, even if Van Huben

were combined with Buchanan in the manner proposed by the Examiner, the resulting

combination of references would fail to teach each and every element of claims 1, 2, 14,

and 15. Claims 8, 9, 21, and 22 are therefore allowable at least due to their

dependence from claims 1, 2, 14, and 15, respectively.

Furthermore, the Examiner alleges that it would have been obvious to a person

having ordinary skill in the art at the time the invention was made to combine Buchanan

and Van Huben because "wherein the application software is spreadsheet software and

the first data is tabular data would be a simple application that would provide tabular

data format and perform sort and search operations on fields." See Office Action,

pages 9-10. Applicant respectfully points out, however, that it "is impermissible within

the framework of section 103 to pick and choose from any one reference only so much

of it as will support a given position, to the exclusion of other parts necessary to the full

appreciation of what such reference fairly suggests to one of ordinary skill in the art."

See In re Wesslau, 147 U.S.P.Q. 391 (C.C.P.A. 1965). *See also* M.P.E.P. § 2141.02, p.

2100-120. Rather, the required motivation to combine references must "be found in the

prior art, and not based on applicant's disclosure." *See* M.P.E.P. § 2143 (emphasis

added).

Since the Examiner has not shown an adequate motivation to combine

Buchanan and Van Huben, claims 8, 9, 21, and 22 are allowable for this reason also.

In addition, the Examiner has not offered any reasonable expectation of success for

modifying the Buchanan system for processing document templates with the Van

Huben method for enabling a central data management system to interact with a

pervasive computing device. Accordingly, the rejection of claims 8, 9, 21, and 22

should be withdrawn for this reason as well.

V. REJECTION OF CLAIMS 10-11 AND 23-24 UNDER § 103(a)

Applicant respectfully traverses the rejection of claims 10-11 and 23-24 under 35

U.S.C. § 103(a) as unpatentable over Buchanan in view of Salas. Claims 10, 11, 23,

and 24 depend from allowable claims 1, 2, 14, and 15, respectively. Salas, which

describes a system and method for providing a collaborative work environment, does

not overcome the above-described shortcomings of Buchanan. Accordingly, for at least

the above reasons, Buchanan and Salas, taken alone or in combination, do not disclose

or suggest all of the features of claims 10-11 and 23-24. Claims 10-11 and 23-24 are

thus allowable at least due to their dependence from claims 1, 2, 14, and 15.

In addition, the Examiner alleges that one of ordinary skill in that the art at the time the invention was made would combine these references "because wherein the application software is browser software and the first data is document data described in a structured tag language such as html would allow users to share files over time zones and geographic boundaries." See Office Action, page 10. Applicant respectfully submits, however, that such unsupported allegations by the Examiner are insufficient evidence for one of ordinary skill to combine Buchanan with Salas. Applicant respectfully submits that claims 10-11 and 23-24 are thus allowable for at least this reason also.

Furthermore, the Examiner has not offered any reasonable expectation of success for modifying the Buchanan system for processing document templates with the Salas system for sharing files. Accordingly, the rejection of claims 10-11 and 23-24 should be withdrawn for this reason as well.

CONCLUSION

In view of the foregoing remarks, Applicant respectfully requests reconsideration

and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge

any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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GARRETT & DUNNER, L.L.P.

Dated: August 6, 2004   By: _____ Reg. No. 53,232

for   Richard V. Burgujian
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Attachment: Replacement Abstract